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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,199	01/29/2001	Richard W. Simmons	13031.1USUI	9114

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EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,199

Applicant(s)

SIMMONS, RICHARD W.

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

DETAILED ACTION

1. This application claims priority to Provisional Application No. 60/179,696 filed on January 28, 2000.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

At page 17, line 14, 16, and 17, there are embedded hyperlinks.

Claim Objections

3. Claim 11 is objected to under 37 CFR 1.75(c) as being in improper form because it depends on both dependent claims 5 and 8. See MPEP § 608.01(n). Accordingly, the claim 11 not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 recites the limitation "third information" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is unclear what is the third information regarding to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 7-8, 10, 12-17, and 19-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Spurgeon (US 5,890,129).

Regarding claims 1 and 22, Spurgeon discloses a computer system and a method (See Figs. 2, 3 and 9) for assembling a database (See Fig. 3, 'insurer database', and col. 6, lines 42-43) regarding claimant eligibility for relief in a multiple-party proceeding (See Fig. 3, for example, 'insurer', 'first provider', 'second provider', 'nth provider' et...), the system and method comprising:

- a client computing system ('Insurer Computer', Fig. 3) for providing access via a computer network ('Local area network', Fig. 3) for filing one or more claims for relief in the multiple-party proceeding (See Figs. 2 and 9, and col. 6, lines 24-29), each of the claims for relief comprising first information regarding a potential claimant and second information regarding the potential claimant's eligibility for relief (See col. 6, lines 29-32); and

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- a server computing system for receiving each of the claims for relief via the computer network ('Information-exchange computer', Fig. 2 or Fig. 3); and
- a validation module for validating each of the claims for relief by comparing either of the first or second information against a pre-defined dataset (See col. 10, lines 19-27).

Regarding claims 2 and 23, Spurgeon discloses all the claimed subject matter, as set forth above in claims 1 and 22 respectively, and further discloses the pre-defined dataset includes a class list of known class members potentially eligible for relief (See col. 20, lines 25-27).

Regarding claim 3, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1 and further discloses associating a unique personal identifier with each of the claims for relief, the unique personal identifier being capable of uniquely identifying the potential claimant (See either 'insured's id number' of Fig. 9, or 'patient SSN' of Fig. 7).

Regarding claim 4, Spurgeon discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a reference string with each of the claims for relief (See either 'insured id number' of Fig. 9, or 'patient SSN' of Fig. 7).

Regarding claim 5, Spurgeon discloses all the claimed subject matter, as set forth above in claim 4, and further discloses:

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- providing the reference string to the potential claimant prior to receiving each of the claims for relief ('member number', Fig. 5, or 'insured id number', Fig. 9); and
- receiving the reference string with each of the claims for relief (See Fig. 9, and col. 9, lines 54-57).

Regarding claim 7, Spurgeon discloses all the claimed subject matter, as set forth above in claim 3, and further discloses associating a unique personal identifier with each of the claims for relief includes associating a keycode with each of the claims for relief ('patient SSN', Fig. 7)¹.

Regarding claim 8, Spurgeon discloses all the claimed subject matter, as set forth above in claim 7, and further discloses receiving the keycode with each of the claims for relief (See col. 9, lines 54-57).

Regarding claim 10, Spurgeon discloses all the claimed subject matter, as set forth above in claim 8, and further Spurgeon states: "Once the claims processing department receives the claim, the staff verifies the member's eligibility" (See col. 10, lines 20-22); here, it is understood that processing claims includes processing the keycode to determine whether the potential claimant may be eligible for relief since keycode is associated with each of the claims.

Regarding claim 12, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access comprises transmitting a computer application via the computer network, the computer application being configured to receive each of the claims for relief (See col. 6, line 66 to col. 7, lines 3).

Regarding claim 13, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access comprises providing a form via the computer network, the form being adapted for receiving each of the claims for relief (See Fig. 9).

Regarding claim 14, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses processing at least one of the first and second information to determine whether the potential claimant may be eligible for relief (See col. 10, lines 19-22).

Regarding claim 15, Spurgeon discloses all the claimed subject matter, as set forth above in claim 14, and further discloses processing at least one of the first and second information comprises defining a criterion for eligibility for relief and determining whether at least part of the second information meets the criterion (See Fig. 7, and col. 6, lines 37-38, and col. 10, lines 19-22).

¹ Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's specification.

Regarding claim 16, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses storing third information associated with receiving each of the claims for relief (See col. 7, lines 34-37).

Regarding claim 17, Spurgeon discloses all the claimed subject matter, as set forth above in claim 16, and further discloses storing the third information comprises storing one selected from the group consisting of a network address from which each of the claims for relief was received (See col. 7, lines 34-37), a date when the each of the claims for relief was received (See Fig. 15, and corresponding text), and a time when each of the claims for relief was received is inherent since the database can be used to store all kinds of data.

Regarding claim 19, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses confirming receipt of the first and second information via the computer network (See col. 10, lines 19-25).

Regarding claim 20, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing a distribution to eligible claimants in the multiple-party proceeding (See col. 10, lines 28-31).

Regarding claim 21, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, and further discloses providing access to the database to at least one party in the multiple-party proceeding thereby allowing the at least one party in the multiple-party

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proceeding to monitor the filing of each of the claims for relief (See Fig. 3, and corresponding text).

Regarding claim 24, Spurgeon discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a reference string that has been provided to potential claimants prior to receiving the first and second information, wherein the reference string is received in connection with the first and second information ('member number', Fig. 5, or 'insured id number', Fig. 9, and col. 9, lines 54-57), and wherein the validation module processes the reference string to determine whether the potential claimant may be eligible for relief (See col. 10, lines 20-22).

Regarding claim 25, Spurgeon discloses all the claimed subject matter, as set forth above in claim 22, and further discloses a keycode received in connection with the first and second information ('patient SSN', Fig. 7)², and wherein the validation module processes the keycode to determine whether the potential claimant may be eligible for relief (See col. 10, lines 20-22).

Regarding claim 26, Spurgeon discloses all the claimed subject matter, as set forth above in claim 22, and further discloses the validation module processes at least one of the first and second information to determine whether the potential claimant may be eligible for relief (See col. 10, lines 20-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Miller (US 5,608,784).

Regarding claim 6, Spurgeon discloses all the claimed subject matter, as set forth above in claim 5, however, Spurgeon is silent as to comparing the reference string provided to the potential claimant against the reference string received with each of the claims for relief. On the other hand, Miller discloses comparing the reference string provided against the reference string received (See col. 5, lines 62-65, Miller et al.). Because Spurgeon system is used to determine and validate claimant eligibility and request (See col. 10, lines 19-25), it would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate the step of comparing the reference string provided to the potential claimant against the reference string received with each of the claims for relief in Spurgeon, as suggested by Miller et al. The motivation would have been enhancing authentication in order to provide relief to claimants.

² Please note that 'keycode' is unique to a member and can be a social security number as exemplified in applicant's specification.

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Regarding claim 9, Spurgeon/Miller discloses all the claimed subject matter, as set forth above in claim 8, and further discloses validating each of the claims for relief comprises comparing the keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

Regarding claim 11, Spurgeon/Miller discloses wherein validating each of the claims for relief comprises:

- comparing the reference string provided to the potential claimant against the reference string received with each of the claims for relief; and
- comparing the keycode received with each of the claims for relief against the pre-defined dataset as addressed above in claim 6.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (US 5,890,129), in view of Ogilvie (US 6,343,738).

Regarding claim 18, Spurgeon discloses all the claimed subject matter, as set forth above in claim 1, however Spurgeon is silent as to receiving a digital signature uniquely identifying the source of each of the claims for relief. On the other hand, Ogilvie discloses using digital signature to authenticate information received (See col. 20, lines 31-34). It would have been obvious to one having ordinary skill in the art at the time of invention was made to incorporate or include digital signature in Spurgeon, as suggested by Ogilvie et al. The motivation would have been uniquely identifying which claimants sent claims for relief.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Giannini U.S Patent No. 5,915,241 discloses method and system encoding and processing alternative healthcare provider billing.

Dang U.S Patent No. 5,835,897 discloses computer-implemented method for profiling medical claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Merilyn P Nguyen whose telephone number is 703-305-5177.

The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



MN

March 21, 2003


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